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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,092	04/03/2001	Yoshitaka Nagao	35.C15264	9326

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FITZPATRICK CELLA HARPER & SCINTO
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 NEW YORK, NY 10112

EXAMINER


COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/824,092	Applicant(s) NAGAO ET AL. 	
	Examiner Elizabeth M Cole	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-28 is/are pending in the application.
- 4a) Of the above claim(s) 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-22 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/11/03 has been entered.

1. Claims 1-7, 9-22 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, it is not clear what is meant by having "a sheet-like shape". How is the plurality of fibers different from a sheet? The claimed structure is not clear.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-3, 14-16, 21-22, 28 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 1,358,345. GB '345 discloses a roofing material comprising a fiber glass sheet which corresponds to the fire resistant material and layer which may be coated on one face with an adhesive which corresponds to the waterproofing layer. The adhesive layer may bond a facing material such as a film layer or other moisture impervious materials. The adhesive may comprise a polyvinyl material. Polyvinyls are known to be thermoplastics. The material may be transported in roll form. See p. 3,

line 98 – page 4, line 95 and page 4, lines 122-126 and figure 6. Since the material may be formed into a roll, it is flexible.

4. Claims 4-7,9,12-13, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,358,345 in view of Michaud, U.S. Patent No. 4,936,070. GB '345 discloses a roofing material as set forth above. GB '345 differs from the claimed invention because GB '345 does not teach applying a filler or resin coating on a portion of the side of the roofing material which will be adhered to the roof. Michaud teaches that the edge portions of roofing materials which will be overlapped in use may be coated with a resin such as an adhesive. See col. 3, lines 27-29. It would have been obvious to have applied an adhesive to the edge portions of the material of GB '345. One of ordinary skill in the art would have been motivated to apply an adhesive to the edge portion of GB '345 by the teaching of Michaud that overlapping the edges with the adhesive coating allows for improved waterproofing of the roof. See col. 3, lines 50-52.
5. Claims 10-11, 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '345 in view of Michaud as applied to claims 4-7,9,12-13, 18-20 above, and further in view of DE 29,801,546, (abstract). Neither GB '345 nor Michaud teach employing metal protective layer. DE '546 teaches that metal foil layers can be used as the protective layer for fibrous roofing materials. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed a metal foil layer as taught by DE '546 instead of or in addition to the polymer films disclosed in GB '345. One of ordinary skill in the art would have been motivated to employ a metal foil

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layer because DE '546 teaches that the metal foil layers also provide barrier properties to the roofing material.

6. Applicant's arguments filed 12/11/03 have been fully considered but they are not persuasive. Applicant argues that GB '345 does not teach impregnating the fibers with a filler but instead uses an adhesive. However, the adhesive employed is a polyvinyl polymer which is a thermoplastic and thus meets Applicant's definition of a filler. With regard to the use of the binder, Applicant's claims do not preclude the use of a binder to bond the fabrics together. The binder in GB '345 is different than the applied adhesive which is coated on only one face of the sheet.

7. With regard to the 112 2nd paragraph rejection, Applicant's arguments have been considered, however, the rejection is maintained because it is not clear how the claimed facing material is different than but similar to a sheet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (703) 872-9306.

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A handwritten signature in cursive script, reading "Elizabeth M. Cole".

Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c